



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,202	06/28/2000	Frank J. Jakubaitis	61466-250470	7617
8791	7590	09/17/2004	EXAMINER	
BLAKELY SOKOLOFF TAYLOR & ZAFMAN 12400 WILSHIRE BOULEVARD SEVENTH FLOOR LOS ANGELES, CA 90025-1030			POND, ROBERT M	
		ART UNIT	PAPER NUMBER	
			3625	

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/607,202	JAKUBAITIS, FRANK J. <i>ST</i>
	Examiner Robert M. Pond	Art Unit 3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 04 June 2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-15 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-15 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 19 April 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Response to Amendment

The Applicant's petition for revival after abandonment was granted. All pending claims (1-15) were examined in this non-final Office Action.

Response to Arguments

Rule 1.105-Information Requirement

The Applicant provided an explanation sufficient to withdraw the request for information.

Rejection under 35 USC 102(e)

Applicant's arguments, see Remarks, filed 19 April 2004, with respect to the rejection(s) of claim(s) 1-15 under 35 USC 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Stefik (Paper #4) and Service-in-a-Box (a collection of prior art cited in Paper #4). Stefik teaches requesting, access, transmitting, and controlling used of digital works, and prior systems of accessing digital works using Internet bulletin board services or commercial networks. Stefik further teaches prepaid vouchers used to download digital works. Service-in-a-Box teaches companies selling packaged product at retail merchant locations that entitles the purchaser access to service and digital information over an electronic bulletin board service. Stefik and

Service-in-a-Box teach or suggest a consumer purchasing a package containing a card with a personal access code used to gain access to services and digital information.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. **Claims 1, 7-9, 11, and 15 are rejected under 35 USC 103(a) as being unpatentable over Stefik et al. (Paper #4, patent number 5,715,403 hereinafter referred to as “Stefik”), in view of Service-in-a-Box (a collection of prior art cited in Paper #4, PTO-892, Items: U-W hereinafter referred to as “SIAB”).**

Stefik teaches a system and method of controlling the distribution and use of digital works using digital tickets as unique IDs associated with each digital work. Stefik teaches a digital work comprising audio or video recordings, software, books, and multimedia publications (see at least col. 1, lines 30-45). Stefik further teaches:

- *Storing the digital works and identification data on a server:* storing digital works in repository server (see Fig. 2 (201, 204); Fig. 7 (701); col. 9, line 18 through col. 11, line 38; col. 12, line 50 through col. 17, line 64).
- *Sending a request to access the desired digital works from the customer node through the public communications network:* (see at least Fig. 1 (104, 105, 107, 108); col. 7, lines 16-48).
- *Receiving at the remote server the request:* (see at least Fig. 1 (104, 105, 107, 108); col. 7, lines 16-48).
- *Transmitting the desired digital work from the remote server:* (see at least Fig. 1 (104, 105, 107, 108); col. 7, lines 16-48).
- *Receiving at the customer node the desired digital work:* (see at least Fig. 1 (104, 105, 107, 108); col. 2, lines 55-67; col. 7, line 16 through col. 8, line 32).
- *Storing the desired digital work on a memory of the customer node:* stores at consumer node (see at least col. 2, line 55 through col. 3, line 7; col. 47, lines 30-33).
- *Searching for digital works:* search and retrieval (see at least col. 49, lines 3-47).
- *Setting status of desired digital work:* limits number of concurrent uses; consumer receives feedback on transaction status (see at least col. 4, lines 25-30; col. 16, lines 64-66).

- Computer systems elements: repository server, communications means, storage system, user interface, and software (see col. 12, line 50 through col. 17, line 64).
- Logic for control and distribution: (see at least Fig. 1 (101-108); Fig. 15 (1501-1525); Fig. 16 (1601-1618); col. 35, lines 4-33).
- Purchasing from the retail merchant a package associated with a desired one of the digital works; package includes digital work's identification data and description of the digital work:

Stefik teaches all the above as noted under the 103(a) rejection and teaches a) a ticket as an indicator that the ticket holder has already paid for or is otherwise entitled to some specific right, product, or service (please note examiner's interpretation: prepaid right, product, or service associated with desired digital work), b) a prior art method of prepaying for a book (see at least col. 2, lines 55-67), c) the purchased voucher containing sufficient information to identify the purchased book (please note examiner's interpretation: description information) and perhaps some demographic information relating to the sales transaction (see at least col. 2, lines 63-66), d) the voucher and a storage medium used to download the book to a point-of-sale kiosk (see at least col. 2, lines 66-67), and further teaches computer bulletin board services on the Internet and commercial networks being used to post and retrieve digital information (see at least col. 1, lines 46-64). Stefik, however, does not teach the

consumer purchasing a package from a retail merchant. SIAB teaches a retail packaging concept used by Digital Equipment Corporation, Hewlett-Packard, and QMS to provide consumers with an off-the-shelf product that is used to purchase service and/or technical support. SIAB teaches HP's a shrink-wrapped box resembling a compact disc jewel box designed to be plucked off the shelf by a consumer. The box holds a service contract (U: see at least page 1). SIAB teaches Digital Equipment's (DEC) software-in-a-box support concept providing unlimited phone support. DEC's off-shelf product is packaged in an 8-inch by 9-inch box and available in stores like CompUSA. Inside the box is a credit-card size card with a personal access number (W: see pages 1-2). SIAB further teaches DEC's service-in-a-box providing the consumer with access to electronic bulletin boards for additional information on products and product resolution summaries. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Stefik to disclose selling a packaged product to consumers in a retail environment representing access entitlement to services or digital information as taught by SIAB, in order for consumers to purchase access to services or digital information in a retail environment, and thereby attract consumers to retail stores interested in purchasing access to digital works.

Pertaining to system Claims 9, 11, and 15

Rejection of Claims 9, 11, and 15 is based upon the same rationale as noted above.

2. **Claims 2, 3, 6, 10, 13, and 14 are rejected under 35 USC 103(a) as being unpatentable over Stefik (Paper #4, patent number 5,715,403) and SIAB (a collection of prior art cited in Paper #4, PTO-892, Items: U-W), as applied to Claim 1, further in view of Fiala et al. (Paper #4, patent number 5,918,909 hereinafter referred to as “Fiala”).**

Stefik and SIAB teach all the above as noted under the 103(a) rejection and teach purchasing a package (e.g. compact disc-like jewel box) from a retail merchant containing a card that contains a personal access number that grants access to service and an electronic bulletin, but do not disclose the unique identifier displayed on an outer surface of the package. Fiala teaches packaging for prepaid cards used to activate a metered account and activating prepaid cards at time of sale. Fiala teaches a unique identifier containing machine-readable optical characters associated with the metered account being exposed on the outer surface and further teaches prepaid cards having a magnetic stripe with encoded identification information (see at least abstract; Fig. 1 (C, S); col. 2, lines 30-36; col. 5, lines 15-20). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Stefik and

SIAB to disclose an identification number displayed on the outer surface package as taught by Fiala, in order to support activation at time of sale.

Pertaining to system Claims 10, 13, and 14

Rejection of Claims 10, 13, and 14 is based upon the same rationale as noted above.

3. **Claims 4 and 12 are rejected under 35 USC 103(a) as being unpatentable over Stefik (Paper #4, patent number 5,715,403), SIAB (a collection of prior art cited in Paper #4, PTO-892, Items: U-W), and Fiala (Paper #4, patent number 5,918,909), as applied to Claim 1.**

Stefik, SIAB, and Fiala teach all the above as noted under the 103(a) rejection and teach a) PIN numbers packaged as being obscured and exposed with unique identifiers packaged as fully exposed or partially exposed, and b) applying a sticker to obscure the PIN, but do not disclose the unique identifier packaged as being obscured. It would have been obvious to one of ordinary skill in the art at time of the invention to disclose fully obscuring the unique identifier with an obscured PIN, since one or ordinary skill in the art would ascertain the identifier could be fully obscured with the techniques disclosed, and thereby provide additional account protection.

Pertaining to system Claim 12

Rejection of Claim 12 is based upon the same rationale as noted above.

4. Claim 5 is rejected under 35 USC 103(a) as being unpatentable over Stefik (Paper #4, patent number 5,715,403) and SIAB (a collection of prior art cited Paper #4, PTO-892, Items: U-W), as applied to Claim 1, further in view of White et al. (patent number 6,169,975 hereinafter referred to as "White").

Stefik and SIAB teach all the above as noted under the 103(a) rejection and teach a) consumers purchasing a package containing a card with a personal access code used to gain access to services and digital information, b) purchasing a voucher that identifies a electronic book and using the voucher to download the book, but do not disclose printing a PIN number for the consumer. White teaches consumers purchasing a prepaid card for services at a point-of-distribution, a prepaid card containing a magnetic strip for reading, and further teaches printing the PIN for the consumer on a paper receipt (see at least abstract; col. 2, lines 23-40). Therefore it would have been obvious to one of ordinary skill in the art to modify the method of Stefik and SIAB to disclose printing a receipt containing the PIN as taught by White, in order for the consumer to know what number is valid for the prepaid card.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Orange County Registrar; "Taking Charge," 28 July 1997, pg d.04, 3pgs, Proquest #13261332; teaches sure.com's prepaid internet access card.
- Sure.com; Interntet Archive Wayback Machine; www.archive.org; 25 April 1998, 2pgs; teaches prepaid Internet access card.
- Rosato, Donna; "Hotels Create Places to Boot Up Before Bedding Down," USA Today, 28 October 1997, pg12B, 2pgs, Proquest #20942873; teaches hotel guests purchasing prepaid Internet access cards.
- Wagner, Mitch; "Alt.cw," Computerworld, 21 July 1997, v31n29pg118, 3pgs, Proquest #13082661; teaches prepaid Internet access cards.
- Xinhua News Agency-CEIS; "S. African Firm Aims at No. 1 Internet Provider," 21 October 1998, 2pgs, Proquest #35307928; teaches prepaid Internet access vouchers available from retail outlets across the country.

- Rozelle; "Optus Buy Microplex," Exchange, 29 May 1998, 1pg, Proquest #30672910; teaches Microplex pioneering prepaid Internet access cards having sold over 80,000.
- Newsbytes; "Hong Kong-DEC Opens Multivendor Service Center," 20 October 1993, Dialog file 636 #02204742; teaches Digital Equipment Corporation's electronic bulletin board service used by members to download software; members receiving discounts.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Vincent Millin** can be reached on 703-308-1065.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

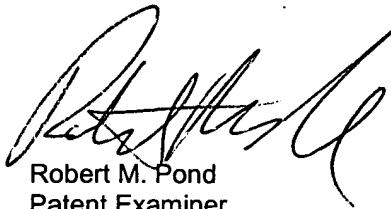
or faxed to:

Application/Control Number: 09/607,202
Art Unit: 3625

Page 12

**703-872-9306 (Official communications; including After Final
communications labeled "Box AF")**

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal
Drive, Arlington, VA, 7th floor receptionist.



Robert M. Pond
Patent Examiner
September 15, 2004